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In re Application of JEN et al
U.S. Application No.: 09/646,478
Int. Application No.: PCT/US99/06947
Int. Filing Date: 30 March 1999
Priority Date: 31 March 1998
Attorney Docket No.: 126881201800
For: METHODS FOR THE DIAGNOSIS AND
TREATMENT OF LUNG CANCER

DECISION

This is in response to applicants' "Renewed Request Under 37 C.F.R. § 1.497(d) and Petition for Suspension of the Rules Under 37 C.F.R. § 1.183" filed 14 May 2002.

BACKGROUND

On 30 March 1999, applicants filed international application PCT/US99/06947, which claimed priority of an earlier United States application filed 31 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 September 2000.

On 15 September 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 17 January 2001, applicants filed a "Response to Notice of Missing Requirements" which included, *inter alia*, a declaration, an assignment document, and the required late declaration surcharge.

On 20 April 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed 17 January 2001 is improper since the declaration lists an inventor who is not listed on the international application.

On 21 May 2001, applicants filed a request to correct inventorship under 37 CFR 1.497(d).

On 14 August 2001, this Office mailed a decision dismissing the 21 May 2001 request to correct inventorship.

On 04 March 2002, applicants filed a renewed request under 37 CFR 1.497(d) along with new declarations.

On 20 March 2002, this Office mailed a decision dismissing the 04 March 2002 renewed request on grounds that consent of the assignee had not been properly established.

On 14 May 2002, applicants filed the present renewed request to add David Sidransky as a joint inventor.

DISCUSSION

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Applicants have previously satisfied items (1) and (2) above.

With regard to item (3) above, the assignee must establish ownership of the application in order to consent to a correction of inventorship. See MPEP 324. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

Documentation relating to the following three entities appears in the application file: 1) AgraQuest, Inc., 2) Genzyme Corporation, and 3) Johns Hopkins University.

AgraQuest Inc.

On 30 March 2001, applicants filed a "Prosecution by Assignee and Power of Attorney Under 37 C.F.R. § 3.71" which states that AgraQuest, Inc. is the assignee of the entire right, title, and interest in the present application. The present renewed request states that this document was filed erroneously without deceptive intent. Applicant's explanation for the discrepancy is accepted.

Genzyme Corporation

On 17 January 2001, applicants filed a "Certificate Under 37 CFR § 3.73(b)" which states that Genzyme Corporation is an assignee of part interest in the present application. The certificate was accompanied by copies of purported assignment agreements signed by joint inventors Gary Beaudry, Stephen Madden and Arthur Bertlesen. At least one of the purported assignment agreements is improper because it contains only a signature page. It is not sufficient to submit only the signature page of an assignment document. Applicants were notified of such defect in the decision mailed 14 August 2001. Applicant must file either 1) a single complete assignment document signed by all of the appropriate inventors or 2) multiple complete assignment documents, with each appropriate inventor's signature appearing on one of the multiple complete assignment documents.

On 04 March 2002, applicants filed a "Consent of Assignees to Change Inventorship" signed by Thomas DesRosier, Chief Patent Counsel. However, Mr. DesRosier's statement neither sets forth that he is authorized to act on behalf of Genzyme Corporation nor does Mr. DesRosier hold a position which is recognized as having apparent authority to act on behalf of a corporation. See MPEP 324. Therefore, the consent document filed 04 March 2002 does not constitute sufficient written consent of the assignee.

Johns Hopkins University

On 30 April 2001, applicants filed a "Statement Under 37 CFR 3.73(b)" which states that Johns Hopkins University is an assignee of part interest in the present application. The statement was accompanied by copies of assignment agreements signed by joint inventor Jin Jen and purported joint inventor David Sidransky. Such assignment agreements properly establish a chain of title from Jen and Sidransky to Johns Hopkins University.

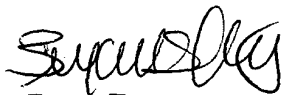
On 04 March 2002, applicants filed a "Consent of Assignees to Change Inventorship" signed by R. Keith Baker, Director, Office of Technology Licensing. However, Mr. Baker's statement neither sets forth that he is authorized to act on behalf of Johns Hopkins University nor does Mr. Baker hold a position which is recognized as having apparent authority to act on behalf of a corporation/university. See MPEP 324. Therefore, the consent document filed 04 March 2002 does not constitute sufficient written consent of the assignee.

CONCLUSION

Because applicants have failed to satisfy item (3) above, the renewed request under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and should also properly establish consent of the assignee as discussed above. Extensions of time may be obtained pursuant to 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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